

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

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Deliver to: Donghee Kang, USPTO Art Group: 2811
Facsimile No.: 703 872-9306 Date: March 2, 2005
From: James Henry, Reg. No. 41,064
Our Docket No.: 42P18281 Number of pages 7 including this sheet.
Application No.: 10/748,446 Filing Date: 12/30/2003
Docket Due Date(s): 3/18/2005

Enclosed are the following documents:

<input checked="" type="checkbox"/> Amendment: <u>Election/Restr.</u> (<u>3</u> pgs)	<input type="checkbox"/> Issue Fee Transmittal
<input type="checkbox"/> Appeal Brief (<u> </u> pgs)	<input type="checkbox"/> Notice of Appeal
<input type="checkbox"/> Application: <u> </u>	<input type="checkbox"/> Petition for: <u> </u>
(<u> </u> pgs) w/cover & abstract)	<input type="checkbox"/> Request for Continued Examination (RCE)
<input type="checkbox"/> Assignment & Cover Sheet (<u> </u> pgs)	<input type="checkbox"/> Reply Brief (<u> </u> pgs)
<input checked="" type="checkbox"/> Certificate of Facsimile <u> </u>	<input type="checkbox"/> Request & Certification Under 35 USC 122(b)(2)(B)(i)
<input type="checkbox"/> Continued Prosecution Application (CPA)	<input type="checkbox"/> Request to Rescind Previous Nonpublication Request
<input type="checkbox"/> Declaration & POA (<u> </u> pgs)	<input type="checkbox"/> Response to Notice of Missing Parts & Formalities Letter
<input type="checkbox"/> Drawings: <u> </u> sheets, <u> </u> figures	<input type="checkbox"/> Response to Written Opinion (<u> </u> pgs)
<input type="checkbox"/> Extension of Time: <u> </u>	<input type="checkbox"/> Terminal Disclaimer
<input checked="" type="checkbox"/> Fee Transmittal (in duplicate)	<input type="checkbox"/> Transmittal of Publication Fee Due
<input type="checkbox"/> IDS & PTO/SB/08 (<u> </u> pgs)	<input checked="" type="checkbox"/> Transmittal Letter
<input type="checkbox"/> Other <u> </u>	

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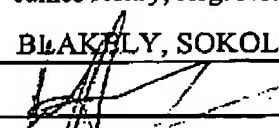
Pat. Sullivan 03/2/2005
Pat Sullivan Date


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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application No.	10/748,446	
	Filing Date	December 30, 2003	
	First Named Inventor	Ashay A. Dani	
	Art Unit	2811	
	Examiner Name	Donghee Kang	
Total Number of Pages in This Submission	7	Attorney Docket Number	42P18281

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;">Facsimile Transmittal Sheet</div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	James Henry, Reg. No. 41,064 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	March 2, 2005

CERTIFICATE OF MAILING/TRANSMISSION			
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Based on PTO/SB/21 (04-04) as modified by Blakely, Sokoloff, Taylor & Zafman (w/r) 08/04/2004.
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

FEE TRANSMITTAL for FY 2005 <small>Patent fees are subject to annual revision.</small>		Complete If Known		
		Application Number	10/748,446	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.		Filing Date	December 30, 2003	
		First Named Inventor	Ashay A. Dani	
		Examiner Name	Donghee Kang	
		Art Unit	2811	
TOTAL AMOUNT OF PAYMENT (\$)		0.00	Attorney Docket No.	42PT8281

METHOD OF PAYMENT (check all that apply)	
<input type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money Order <input type="checkbox"/> None <input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input type="checkbox"/> Charge fee(s) indicated below <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee	
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20. <input type="checkbox"/> Credit any overpayments	

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SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	James Henry	Registration No. (Attorney/Agent)	41,064
Signature		Telephone	(714) 557-3800
		Date	03/02/05

Based on PTO/SD-17 (12-04) as modified by Blakely, Sokoloff, Taylor & Zafman (MTR) 12/16/2004
 SEND TO: Commissioner for Patents, P.O. Box 1480, Alexandria, VA 22313-1450

Appl. No. 10/748,446
Amdt. dated 03/02/2005
Reply to Office Action of 02/18/2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/748,446
Applicant : Ashay A. Dani
Filed : 12/30/2003
TC/A.U. : 2811
Examiner : KANG, DONGHEE

Docket No. : 42P18281
Customer No. : 8791

Confirmation No. 2353

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

AMENDMENT

Sir:

In response to the Office action of 02/18/2005, please amend the above-identified application as follows:

The claims are not amended.

Remarks/Arguments begin on page 2 of this paper.

Appl. No. 10/748,446
Amdt. dated 03/02/2005
Reply to Office Action of 02/18/2005

REMARKS

This Amendment is in response to the Office Action mailed 02/18/2005. In the Office Action, the Examiner issued an Election/Restriction requirements.

In view of the Examiner's restriction requirement, applicant retains the right to present claims 1-8 in a divisional application

Election/Restriction

1. The Examiner requires restriction to one of the following inventions:

- I. Claims 1-8, drawn to a semiconductor device.
- II. Claims 9-30, drawn to a method of making a semiconductor device.

Applicant elects invention II, claims 9-30, with traverse.

Traverse

2. The Examiner asserts that inventions II and I are related as process of making and product made. Applicant respectfully disagrees. Invention II is a process of separating a silicon wafer having a protective coat and invention I is a silicon wafer having a protective coat. Applicant respectfully submits that inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

The Examiner asserts that the inventions are distinct because the product as claimed can be made by another materially different process. The Examiner asserts that the product as claimed can be made by scribing the wafer using mechanical grinding instead of laser scribing. Applicant respectfully points out that invention I is claimed as a silicon wafer and scribing is not an element of the claimed invention. Therefore the product as claimed can be made without scribing by any process.

Applicant respectfully submits that claims 1-8 claim an invention for which Election/Restriction is not appropriate.

Appl. No. 10/748,446
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Conclusion

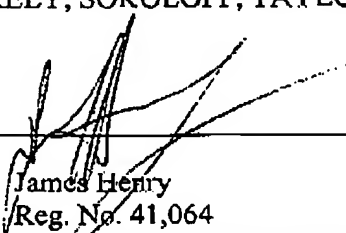
Applicant respectfully requests examination on the merits in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 03/02/2005

By


James Henry
Reg. No. 41,064
Tel.: (714) 557-3800 (Pacific Coast)